

REMARKS

Applicant has amended claims 15 and 20 to properly depend from claims 13 and 18, respectively. Applicant respectfully requests entry of the amendment of claims 15 and 20 to place the claims in better condition for appeal. Applicants respectfully contend that the amendment of claims 15 and 20 does not raise any new issues, since the Examiner's arguments in the present final office action assume that claims 15 and 20 depend from claims 13 and 18, respectively.

The Examiner rejected claims 1, 7, 13, 24, 26-27, 34-35, and 38-39 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sims et al. (5,434,775) in view of Bates (6,057,779), for substantially the same reasons as given in the previous Office Action (paper number 8), and further in view of Maynard (5,949,335) and Bridges, Jr. et al. (4,141,078).

The Examiner rejected claims 3-5, 15-16, 25, 28-29, and 41 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sims et al. (5,434,775), Bates (6,057,779), Maynard (5,949,335), and Bridges, Jr. et al. (4,141,078) as applied to claim 1, and further in view of Guthrie et al. (5,289,372).

The Examiner rejected claims 8-10, 18, 20-22, 30-33 and 36-37 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sims et al. (5,434,775), in view of Bates (6,057,779) and Guthrie et al. (5,289,372), for substantially the same reasons as given in the previous Office Action (paper number 8), and further in view of Maynard (5,949,335) and Bridges, Jr. et al. (4,141,078).

Applicant respectfully traverses the §103(a) rejections with the following arguments.

35 U.S.C. §103(a): Claims 1, 7, 13, 24, 26-27, 34-35, and 38-39

The Examiner rejected claims 1, 7, 13, 24, 26-27, 34-35, and 38-39 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sims et al. (5,434,775) in view of Bates (6,057,779), for substantially the same reasons as given in the previous Office Action (paper number 8), and further in view of Maynard (5,949,335) and Bridges, Jr. et al. (4,141,078).

Applicant respectfully contends that claims 1, 13, and 24 are not unpatentable over Sims in view of Bates, because Sims in view of Bates and further in view of Maynard and Bridges does not teach or suggest each and every feature of claims 1, 13, and 24.

As a first example of why Sims in view of Bates and further in view of Maynard and Bridges does not teach or suggest each and every feature of claims 1, 13, and 24, Sims in view of Bates and further in view of Maynard and Bridges does not teach or suggest the feature: "each asset of said assets being independently selected from the group consisting of a computer hardware asset and a computer software asset".

The Examiner argues: "Sims and Bates do not expressly disclose the asset being a computer hardware asset and a computer software asset. Maynard discloses the asset being processors, work stations, monitors, printers, scanners and network servers, and software (col. 1 lines 50-67).... At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Maynard within the method of Sims and Bates with the motivation of preventing theft throughout the supply chain (Maynard; col. 1 lines 18-22)."

In response, Applicant notes that Maynard, col. 1, lines 24-29 recites: "The long-felt need

of the prior art for a theft detection system throughout the supply chain of the computer industry is satisfied by methods and apparatus for identifying assets that connect to a local area network (LAN) or a wide area network (WAN) area network and integrating those assets with an RFID tagging system." Applicants maintain that the preceding quote from Maynard does not teach or suggest that preventing theft throughout the supply chain is a consequence of the assets being hardware assets or computer software assets, as implied by the Examiner's argument. Rather, the preceding quote from Maynard teaches that preventing theft throughout the supply chain is due to the methods and apparatus for identifying assets disclosed by Maynard.

As a second example of why Sims in view of Bates and further in view of Maynard and Bridges does not teach or suggest each and every feature of claims 1, 13, and 24, Sims in view of Bates and further in view of Maynard and Bridges does not teach or suggest the feature: "said assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites".

The Examiner argues: "Sims and Bates do not expressly disclose "assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites". Bridges discloses a centralized computer system for checking out an item, where the item must be returned to central location before being checked out again (Bridges; col. 1 line 40 to col. 2 line 45, col. 4 lines 15-60). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Bridges within the method of Sims and Bates with the motivation of maximizing control and accuracy over items (col. 3 lines 29-40)."

In response, Applicant respectfully contends that the preceding argument by the Examiner has not identified the plurality of sites, the first site, and the second site satisfying the limitations in the preceding feature of claims 1, 13, and 24. Applicant refers specifically to FIG. 1 described by Bridges, col. , lines 15-60 as cited by the Examiner. If the Examiner is alleging that the book processor stations 30 of FIG. 1 represent the plurality of sites and that books represent the assets of the preceding feature of claims 1, 13, and 24, then Applicant respectfully contends that Bridges does not teach anywhere that the books are moveable between a plurality of book processor stations only by being routed through said central site and not being moveable directly from a first book processor station to a second book processor station of the plurality of book processor stations. Also, Applicant disagrees that Bridges discloses a centralized computer system for checking out an item, where the item must be returned to central location before being checked out again. Applicants respectfully request that the Examiner indicate the specific language in Bridges that allegedly discloses a centralized computer system for checking out an item, where the item must be returned to central location before being checked out again.

Moreover, the Examiner's allegation that Bridges discloses a centralized computer system for checking out an item, where the item must be returned to central location before being checked out again is not a disclosure of: "said assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites". Applicant contends that the preceding allegation by the Examiner, even if correct, is silent about communication between the plurality of sites. Applicants maintain that Bridges does not disclose "said assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly

from a first site to a second site of the plurality of sites”.

In addition, the books or any other movable items (if any) disclosed by Bridges cannot represent the assets of claims 1, 13, and 24, since books are not hardware assets or computer software assets.

On the other hand, if the Examiner is not alleging that the book processor stations 30 of FIG. 1 represent the plurality of sites and that the books represent the assets of the preceding feature of claims 1, 13, and 24, then Applicant respectfully requests the Examiner to be specific as to what in Bridges allegedly represents the plurality of sites and assets of the preceding feature of claims 1, 13, and 24, and to explain clearly with specificity as to how the preceding feature of claims 1, 13, and 24 is allegedly disclosed by Bridges. In other words, Applicant respectfully requests the Examiner to indicate the specific language in Bridges that allegedly discloses “said assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites”.

Furthermore, Applicant maintains that the Examiner’s argument for modifying Sims and Bates by the alleged teaching of Bridges is not supported by Bridges, col. 3, lines 29-40 as alleged by the Examiner. In particular, Bridges, col. 3, lines 29-30 recites: “Additional security features are included in the system to maximize control and accuracy” However, Bridges does not disclose that any of said additional security features relate to the preceding feature of claims 1, 13, and 24. Accordingly, Applicant respectfully contends that the Examiner has not established a *prima facie* case of obviousness in relation to claims 1, 13, and 24.

As a third example of why Sims in view of Bates and further in view of Maynard and

Bridges does not teach or suggest each and every feature of claims 1, 13, and 24, Sims in view of Bates and further in view of Maynard and Bridges does not teach or suggest the feature: "recording the intended destination site in said database; and verifying entry of the asset at the destination site, **being a new current location**, in said database" (emphasis added).

The Examiner argues: "Sims fails to expressly disclose recording the intended destination site in said database Bates discloses storing in memory a desired geographical location (reads on "recording the intended destination site") and comparing the stored geographical location to a respective determined geographical location to determine whether cargo (reads on "asset") falls within the desired geographical location, wherein the respective determined geographical location is stored in memory (Fig. 7-8, col. 1 lines 35-46, col. 1 line 65 to col. 2 line 7, col. 2 lines 19-40, col. 4 lines 3-63, col. 5 lines 43-55). The teachings of a database are disclosed by Sims, and are discussed above...."

In response, Applicant contends that Bates does not disclose the "being a new current location" aspect of the preceding feature of claims 1, 13, and 24. Moreover, the preceding argument by the Examiner does not even allege that Bates discloses the "being a new current location" aspect of the preceding feature of claims 1, 13, and 24. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claims 1, 13, and 24.

In addition, Applicant notes that the Examiner alleges that the cargo in Bates represents the asset in claims 1, 13, and 24. However, cargo is not a computer hardware asset or a computer software asset as required by claims 1, 13, and 24. Applicant maintains that the Examiner's use of Maynard as allegedly disclosing "the asset being processors, work stations, monitors, printers, scanners and network servers, and software" is an improper modification of the secondary

reference of Bates. The Examiner argues that the primary reference of Sims discloses various features of claims 1, 13, and 24. The Examiner also argues that the secondary reference of Bates has modified the primary reference of Sims, by alleging that Bates teaches or suggests storing in memory a desired geographical location and comparing the stored geographical location to a respective determined geographical location to determine whether cargo falls within the desired geographical location, **such that cargo is an asset**. The Examiner additionally argues that the secondary reference of Maynard has modified the secondary reference of Bates, by alleging that Maynard teaches or suggests "the asset being processors, work stations, monitors, printers, scanners and network servers, and software". Applicant maintains that it is improper to argue that a claim feature is taught or suggested by a secondary reference through modification of another secondary reference. If the Examiner could modify a secondary reference in the preceding manner, then the Examiner would be able to show the existence of any element or feature of any claim merely by chaining a sufficient number of secondary references together in the preceding manner. Accordingly, Applicants respectfully maintain that the rejection of claims 1, 13, and 24 under 35 U.S.C. §103(a) is improper.

As a fourth example of why Sims in view of Bates and further in view of Maynard and Bridges does not teach or suggest each and every feature of claims 1, 13, and 24, Sims in view of Bates and further in view of Maynard and Bridges does not teach or suggest the feature: "recording the location of said asset with respect to said central site in an electronic database; and **on each movement of said asset**" (emphasis added).

The Examiner has not presented any argument directed to the preceding feature of claims

1, 13, and 24. While the Examiner has alleged that Sims discloses "recording the location of said asset with respect to said central site in an electronic database", the Examiner has not alleged that Sims discloses the "on each movement of said asset" aspect of the preceding feature of claims 1, 13, and 24. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claims 1, 13, and 24.

Based on the preceding arguments, Applicants respectfully maintain that claims 1, 13, and 24 are not unpatentable over Sims in view of Bates and further in view of Maynard and Bridges, and that claims 1, 13, and 24 are in condition for allowance. Since claims 7 and 26-27 depend from claim 1, Applicants contend that claims 7 and 26-27 are likewise in condition for allowance. Since claims 34-35 depend from claim 13, Applicants contend that claims 34-35 are likewise in condition for allowance. Since claims 38-39 depend from claim 24, Applicants contend that claims 38-39 are likewise in condition for allowance.

35 U.S.C. §103(a): Claims 3-5, 15-16, 25, 28-29, and 41

The Examiner rejected claims 3-5, 15-16, 25, 28-29, and 41 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sims et al. (5,434,775), Bates (6,057,779), Maynard (5,949,335), and Bridges, Jr. et al. (4,141,078) as applied to claim 1, and further in view of Guthrie et al. (5,289,372).

Since claims 3-5 and 28-29 depend from claim 1, which Applicants have argued *supra* to not be unpatentable over Sims in view of Bates and further in view of Maynard and Bridges under 35 U.S.C. §103(a), Applicants maintain that claims 3-5 and 28-29 are likewise not unpatentable over Sims in view of Bates and further in view of Maynard and Bridges and Guthrie under 35 U.S.C. §103(a).

Since claims 15-16 depend from claim 13, which Applicants have argued *supra* to not be unpatentable over Sims in view of Bates and further in view of Maynard and Bridges under 35 U.S.C. §103(a), Applicants maintain that claims 15-16 are likewise not unpatentable over Sims in view of Bates and further in view of Maynard and Bridges and Guthrie under 35 U.S.C. §103(a).

Since claims 25 and 41 depend from claim 24, which Applicants have argued *supra* to not be unpatentable over Sims in view of Bates and further in view of Maynard and Bridges under 35 U.S.C. §103(a), Applicants maintain that claims 25 and 41 are likewise not unpatentable over Sims in view of Bates and further in view of Maynard and Bridges and Guthrie under 35 U.S.C. §103(a).

35 U.S.C. §103(a): Claims 8-10, 18, 20-22, 30-33 and 36-37

The Examiner rejected claims 8-10, 18, 20-22, 30-33 and 36-37 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sims et al. (5,434,775), in view of Bates (6,057,779) and Guthrie et al. (5,289,372), for substantially the same reasons as given in the previous Office number 8), and further in view of Maynard (5,949,335) and Bridges, Jr. et al. (4,141,078).

Applicant respectfully contends that claims 8 and 18 are not unpatentable over Sims in view of Bates and Guthrie and further in view of Maynard and Bridges, because Sims in view of Bates and Guthrie and further in view of Maynard and Bridges does not teach or suggest each and every feature of claims 8 and 18.

As a first example of why Sims in view of Bates and Guthrie and further in view of Maynard and Bridges does not teach or suggest each and every feature of claims 8 and 18, Sims in view of Bates and Guthrie and further in view of Maynard and Bridges does not teach or suggest the feature: "each asset of said assets being independently selected from the group consisting of a computer hardware asset and a computer software asset".

The Examiner argues: "Sims and Bates do not expressly disclose the asset being a computer hardware asset and a computer software asset. Maynard discloses the asset being processors, work stations, monitors, printers, scanners and network servers, and software (col. 1 lines 50-67).... At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Maynard within the method of Sims and Bates with the motivation of preventing theft throughout the supply chain (Maynard; col. 1 lines 18-22)."

09/657,039

20

In response, Applicant notes that Maynard, col. 1, lines 24-29 recites: "The long-felt need of the prior art for a theft detection system throughout the supply chain of the computer industry is satisfied by methods and apparatus for identifying assets that connect to a local area network (LAN) or a wide area network (WAN) area network and integrating those assets with an RFID tagging system." Applicants maintain that the preceding quote from Maynard does not teach or suggest that preventing theft throughout the supply chain is a consequence of the assets being hardware assets or computer software assets, as alleged by the Examiner's argument. Rather, the preceding quote from Maynard teaches that preventing theft throughout the supply chain is due to the methods and apparatus for identifying assets disclosed by Maynard.

As a second example of why Sims in view of Bates and Guthrie and further in view of Maynard and Bridges does not teach or suggest each and every feature of claims 8 and 18, Sims in view of Bates and Guthrie and further in view of Maynard and Bridges does not teach or suggest the feature: "said assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites".

The Examiner argues: "Sims and Bates do not expressly disclose "assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites". Bridges discloses a centralized computer system for checking out an item, where the item must be returned to central location before being checked out again (Bridges; col. 1 line 40 to col. 2 line 45, col. 4 lines 15-60). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to

combine the teachings of Bridges within the method of Sims and Bates with the motivation of maximizing control and accuracy over items (col. 3 lines 29-40)."

In response, Applicant respectfully contends that the preceding argument by the Examiner has not identified the plurality of sites, the first site, and the second site satisfying the limitations in the preceding feature of claims 8 and 18. Applicant refers specifically to FIG. 1 described by Bridges, col. , lines 15-60 as cited by the Examiner. If the Examiner is alleging that the book processor stations 30 of FIG. 1 represent the plurality of sites and that books represent the assets of the preceding feature of claims 8 and 18, then Applicant respectfully contends that Bridges does not teach anywhere that the books are moveable between a plurality of book processor stations only by being routed through said central site and not being moveable directly from a first book processor station to a second book processor station of the plurality of book processor stations. Also, Applicant disagrees that Bridges discloses a centralized computer system for checking out an item, where the item must be returned to central location before being checked out again. Applicants respectfully request that the Examiner indicate the specific language in Bridges that allegedly discloses a centralized computer system for checking out an item, where the item must be returned to central location before being checked out again.

Moreover, the Examiner's allegation that Bridges discloses a centralized computer system for checking out an item, where the item must be returned to central location before being checked out again is not a disclosure of: "said assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites". Applicant contends that the preceding allegation by the Examiner, even if correct, is silent about communication between the plurality of sites.

09/657,039

22

Applicants maintain that Bridges does not disclose "said assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites".

In addition, the books or any other movable items disclosed by Bridges cannot represent the assets of claims 8 and 18, since books are not hardware assets or computer software assets.

On the other hand, if the Examiner is not alleging that the book processor stations 30 of FIG. 1 represent the plurality of sites and that the books represent the assets of the preceding feature of claims 8 and 18, then Applicant respectfully requests the Examiner to be specific as to what in Bridges allegedly represents the plurality of sites and assets of the preceding feature of claims 8 and 18, and to explain clearly with specificity as to how the preceding feature of claims 8 and 18 is allegedly disclosed by Bridges. In other words, Applicant respectfully requests the Examiner to indicate the specific language in Bridges that allegedly discloses "said assets being moveable between a plurality of sites only by being routed through said central site and not being moveable directly from a first site to a second site of the plurality of sites".

Furthermore, Applicant maintains that the Examiner's argument for modifying Sims and Bates by the alleged teaching of Bridges is not supported by Bridges, col. 3, lines 29-40 as alleged by the Examiner. In particular, Bridges, col. 3, lines 29-30 recites: "Additional security features are included in the system to maximize control and accuracy" However, Bridges does not disclose that any of said additional security features relate to the preceding feature of claims 8 and 18. Accordingly, Applicant respectfully contends that the Examiner has not established a *prima facie* case of obviousness in relation to claims 8 and 18.

As a third example of why Sims in view of Bates and Guthrie and further in view of Maynard and Bridges does not teach or suggest each and every feature of claims 8 and 18, Sims in view of Bates and Guthrie and further in view of Maynard and Bridges does not teach or suggest the feature: "recording the intended destination site in said database; and verifying entry of the asset at the destination site, **being a new current location**, in said database" (emphasis added).

The Examiner argues: "Sims fails to expressly disclose recording the intended destination site in said database Bates discloses storing in memory a desired geographical location (reads on "recording the intended destination site") and comparing the stored geographical location to a respective determined geographical location to determine whether cargo (reads on "asset") falls within the desired geographical location, wherein the respective determined geographical location is stored in memory (Fig. 7-8, col. 1 lines 35-46, col. 1 line 65 to col. 2 line 7, col. 2 lines 19-40, col. 4 lines 3-63, col. 5 lines 43-55). The teachings of a database are disclosed by Sims, and are discussed above...."

In response, Applicant contends that Bates does not disclose the "being a new current location" aspect of the preceding feature of claims 8 and 18. Moreover, the preceding argument by the Examiner does not even allege that Bates discloses the "being a new current location" aspect of the preceding feature of claims 8 and 18. Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claims 8 and 18.

In addition, Applicant notes that the Examiner alleges that the cargo in Bates represents the asset in claims 8 and 18. However, cargo is not a computer hardware asset or a computer software asset as required by claims 8 and 18. The Examiner's use of Maynard as allegedly

disclosing "the asset being processors, work stations, monitors, printers, scanners and network servers, and software" is an improper modification of the secondary reference of Bates. The Examiner argues that the primary reference of Sims discloses various features of claims 8 and 18. The Examiner also argues that the secondary reference of Bates has modified the primary reference of Sims, by alleging that Bates teaches or suggests storing in memory a desired geographical location and comparing the stored geographical location to a respective determined geographical location to determine whether cargo falls within the desired geographical location, such that cargo is an asset. The Examiner additionally argues that the secondary reference of Maynard has modified the secondary reference of Bates, by alleging that Maynard teaches or suggests "the asset being processors, work stations, monitors, printers, scanners and network servers, and software". Applicant maintains that it is improper to argue that a claim feature is taught or suggested by a secondary reference through modification of another secondary reference. If the Examiner could modify a secondary reference in the preceding manner, then the Examiner would be able to show the existence of any element or feature of any claim merely by chaining a sufficient number of secondary references together in the preceding manner. Accordingly, Applicants respectfully maintain that the rejection of claims 8 and 18 under 35 U.S.C. §103(a) is improper.

As a fourth example of why Sims in view of Bates and Guthrie and further in view of Maynard and Bridges does not teach or suggest each and every feature of claims 8 and 18, Sims in view of Bates and Guthrie and further in view of Maynard and Bridges does not teach or suggest the feature: "recording configuration information ... on each movement of said asset".

09/657,039

25

The Examiner has not presented any argument directed to the preceding feature of claims 8 and 18. While the Examiner has alleged that Sims discloses "movement of said asset, the Examiner has not alleged that Sims discloses "recording configuration information ... on each movement of said asset". Thus, the Examiner has not established a *prima facie* case of obviousness in relation to claims 8 and 18.

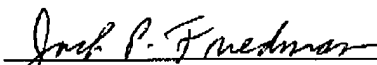
Based on the preceding arguments, Applicant respectfully maintains that claims 8 and 18 are not unpatentable over Sims in view of Bates and Guthrie and further in view of Maynard and Bridges, and that claims 8 and 18 are in condition for allowance. Since claims 9-10 and 30-33 depend from claim 8, Applicants contend that claims 9-10 and 30-33 are likewise in condition for allowance. Since claims 20-22 and 36-37 depend from claim 18, Applicants contend that claims 20-22 and 36-37 are likewise in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457.

Date: 01/25/2005

Schmeiser, Olson & Watts
3 Lear Jet Lane, Suite 201
Latham, New York 12110
(518) 220-1850



Jack P. Friedman
Registration No. 44,688

09/657,039

27